

REMARKS/ARGUMENTS

As an initial matter, Applicant wishes to thank the Examiner for discussing proposed claim amendments in a telephonic interview on January 8, 2004.

Claims 1-34 are currently pending in the present application. Claims 1, 26 and 31 have been amended. Support for the amendments can be found, for example, in the claims as filed and in the specification on page 35, lines 10-31. Claims 25 and 30 have been canceled without prejudice to subsequent revival. Upon entry of the present amendments, claims 1-24, 26-29, and 31-34 will be pending.

Rejection under 35 U.S.C. § 102(e)

Claim 1-11, 18, 21-24 and 33-34 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Gould-Fogerite (US Patent No. 5,994,318) as defined by New (US Patent No. 6,368,619). To the extent the rejection applies to the claims as amended, Applicant respectfully traverses. Claim 1 as amended includes the subject matter set forth in canceled claim 25 and 30. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 1-16, 18-24, 30 and 32-34 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Gould-Fogerite in view of New and further in view of Yoshioka (US Patent No. 5,593,622) and Riess (US Patent No. 5,344,930). Claim 1, as amended, recites that the claimed composition comprises a gas, a gaseous precursor, a gas and a gaseous precursor, a liquid perfluorocarbon compound or a liquid perfluoroether compound. To the extent the rejection applies to the claims as amended, Applicant respectfully traverses.

As is stated in M.P.E.P. § 2143, three criteria must be met to establish prima facie obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and

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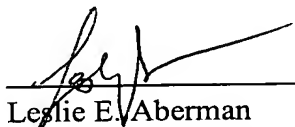
the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, a *prima facie* case of obviousness has not been established, at least because there is no suggestion or motivation to modify the references.

The Office Action fails to identify any motivation or suggestion in the cited references to include a gas, a gaseous precursor, a gas and a gaseous precursor, a liquid perfluorocarbon compound or a liquid perfluoroether compound in the claimed compositions. Accordingly, Applicant respectfully requests that the rejection of the claims under 35 U.S.C. § 103 be withdrawn.

The foregoing represents a *bona fide* attempt to advance the present case to allowance. Applicant submits that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

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